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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,045	10/31/2000	Louis J. Morsberger	MFSI-001/01US	8530
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COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			ROBINSON BOYCE, AKIBA K	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/702,045

Applicant(s)

MORSBERGER, LOUIS J.

Examiner

Akiba K Robinson-Boyce

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Due to communications filed 4/19/04, the following is a non-final first office action. Claims 1-17 and 19 have been amended. Claims 1-20 are pending in this application and have been examined on the merits. Claims 1-20 have been rejected as follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US 6,260,024), and further in view of Pinsley et al (US 6,070,145).

As per claim 1, Shkedy discloses:

receiving transaction information related to a transaction, the transaction information including consumer information and merchant information, (Col. 5, lines 13-15, lines 28-30, [buyer identification, specification of item, quantity represents transaction data, seller bidding date represents merchant information], Col. 6, lines 8-10, [sellers identifying PPOs relevant to their products also represents seller information]);

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comparing the consumer information with predetermined consumer information, (Col. 5, lines 61-63, [authenticating against the buyer database]);

comparing the merchant information with predetermined merchant information, (Col. 6, lines 22-23, authenticating the identification of a seller], (Col. 30, lines 1-3, [comparing with seller identification database];

Shkedy fails to disclose the following, however Pinsley et al discloses:

determining whether to invite the consumer to complete a survey related to the transaction, (Col. 4, lines 9-11, [where the offer is made based on the conclusion of a transaction]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine whether to invite the consumer to complete a survey related to the transaction with the motivation of collecting the owner's views in order to get a better idea of how to improve the processing of the transaction.

As per claim 2, Shkedy discloses:

wherein the consumer information includes a consumer identification code, and the predetermined consumer information includes information relating to consumers defined as prospective offerees, (Col. 5, lines 13-15, [buyer identification], w/ Col. 7, lines 26-32, [pre-negotiated seller contract with prospective buyers]).

As per claim 3, Shkedy discloses:

wherein the predetermined merchant information includes information relating to categories of purchases, and wherein determining whether to invite

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the consumer to complete a survey includes determining whether the transaction corresponds to one of said categories of purchases, (Col. 7, lines 33-42, [pre-negotiates a contract, collective buyer pool]).

As per claim 4, Shkedy discloses:

wherein determining whether the transaction corresponds to one of said categories of purchases includes determining whether there is an unsatisfied quota of survey invitations for the particular type of transaction, (Ab, lines 12-14, [resolve disputes]).

As per claim 5, Shkedy fails to disclosed the following, however Pinsley et al discloses:

wherein determining whether to invite the consumer to complete a survey includes determining whether the transaction meets predetermined criteria and is a qualifying transaction, (Col. 4, lines 8-11, [conclusion of transaction]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine whether to invite the consumer to complete a survey including determining whether the transaction meets predetermined criteria and is a qualifying transaction with the motivation of filtering out all of the consumers who's transaction does not correspond with the questions of the survey.

As per claim 6, Shkedy fails to disclosed the following, however Pinsley et al discloses:

transmitting to the consumer an invitation to complete a survey relating to the qualifying transaction, (Col. 4, lines 48-49, [transmitting]);

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receiving survey information from the consumer relating to the qualifying transaction, (Col. 3, lines 5-6, [information collected]);and

processing the received survey information, (Col. 3, line 62, [processed]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit a survey, receive the survey information and process the received survey information with the motivation of obtaining relevant feedback information about a customer's transaction.

As per claim 7, Shkedy discloses:

wherein the predetermined consumer information is provided by a party to the transaction other than the merchant, (Col. 1, lines 8-12, [intermediary]).

As per claim 8, Shkedy fails to disclosed the following, however Pinsley et al discloses:

offering processed survey information to a merchant; and granting access to the processed survey information to the merchant, (Col. 3, line 6, [information delivered to advertiser where the advertiser represents the merchant]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to offer and grant access to the processed survey information to the merchant with the motivation of allowing the merchant to access customer information about the transaction that will help with the improvement of future transactions.

As per claim 9, Shkedy discloses:

wherein the transaction information includes a transaction record, the transaction record being in at least one of an electronic form and a digital form,

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and receiving transaction information includes receiving a set of transaction information regarding several transactions, (Col. 13, lines 7-8, [FPO represents the record], Col. 13, lines 31-34, [electronic contract], w/ Ab, lines 7-12, [facilitating transactions by aggregating offers]).

As per claim 10, Shkedy discloses:

receiving consumer information from participating consumers, (Col. 5, lines 13-15, [buyer identification]);

developing historical consumer information for each of the participating consumers, (Col. 10, lines 1-7, [credit history]);

receiving transaction information relating to a transaction, the transaction information including information relating to the consumer in the transaction, (Col. 5, lines 13-15, [buyer identification]);

determining, using the information relating to the consumer in the transaction, whether the consumer in the transaction is a participating consumer, (Col. 5, lines 13-15, [buyer items]); and

determining, using the historical consumer information, (Col. 10, lines 1-7, [credit history of transactions],

Shkedy fails to disclosed the following, however Pinsley et al discloses:

inviting consumers to participate in a survey program, (Col. 4, lines 44-45, [offering]);

determining...whether to collect survey information from the consumer in the transaction, (Col. 4, lines 9-11, [offer to participate is made at the conclusion of a transaction based on pre-determined criteria]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to invite consumers to participate in a survey program and to determine whether to collect survey information from the consumer in the transaction with the motivation of determining if the consumer would be worth keeping and performing transactions with.

As per claim 12, Shkedy discloses:

wherein the transaction information includes at least one of the category of the transaction and the payment amount of the transaction, and determining whether to solicit survey information from the consumer in the transaction includes using at least one of the category of the transaction and the payment amount of the transaction, (Col. 5, lines 10-11, [category included in FPO], w/ Col. 5, line 67-Col. 6, line 3, [authenticating and adding to FPO]).

As per claim 13, Shkedy fails to disclosed the following, however Pinsley et al discloses:

wherein soliciting survey information includes transmitting a survey invitation to the consumer to the transaction, (Col. 4, lines 41-45, [transmitting/offering], and the survey invitation includes instructions regarding the survey, (Ab, lines 3-5, [instructions into an information document])).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit the survey invitation to the consumer and to include instructions with the motivation of allowing the consumer to have accessibility to a survey that can be easily interpreted.

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As per claim 14, Shkedy fails to disclosed the following, however Pinsley et al discloses:

wherein the survey invitation includes a survey instrument, (Col. 6, line 31, [survey document]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the survey invitation to include a survey instrument with the motivation of providing something tangible which would assist a user in documented answers to survey questions.

As per claim 15, Shkedy discloses:

wherein the transaction information includes a transaction record, the transaction record being in at least one of an electronic form and a digital form, and receiving transaction information includes receiving a set of transaction information regarding several transactions, (Col. 13, lines 7-8, [FPO represents the record], Col. 13, lines 31-34, [electronic contract], w/ Ab, lines 7-12, [facilitating transactions by aggregating offers]).

As per claim 16, Shkedy discloses:

a monitoring interface processing transaction information from the transaction, (Col. 13, lines 8-9, [central controller {200}], the transaction information including a transaction record with information relating to the consumer to the transaction, Col. 13, lines 7-8, [FPO represents the record], the transaction record being in at least one. of an electronic form and a digital form, Col. 13, lines 31-34, [electronic contract];

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a processor analyzing said transaction record relative to stored consumer information, (Col. 12, line 2, [processing device]); and

a participant interface enabling the consumer to the transaction to provide...information, (Col. 13, line 10, [buyer interface]);

the processor determining whether the consumer to the transaction is a participant in a survey and determining whether to solicit survey information from the consumer to the transaction/provide survey information, (Col. 4, lines 8-11, [offer to participate based on selection criteria]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to determine whether the consumer to the transaction is a participant in a survey and determining whether to solicit survey information from the consumer to the transaction with the motivation of determining if the consumer would be worth keeping and performing transactions with.

As per claim 17, Shkedy discloses:

wherein the transaction record includes information relating to at least one of the category of the transaction and a payment amount of the transaction, and said processor determines whether to solicit survey information based on at least one of the category of the transaction and the payment amount of the transaction, (Col. 5, lines 10-11, [category included in FPO], w/ Col. 5, line 67-Col. 6, line 3, [authenticating and adding to FPO]).

As per claim 18, Shkedy discloses:

wherein the information relating to the consumer to the transaction includes an identification code for the consumer to the transaction, (Col. 5, lines

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13-15, [buyer identification]), and the processor compares identification codes of consumers to transactions with predetermined identification codes of participants in the survey, (Col. 5, lines 61-63, [authenticating buyer identification number against a buyer database]).

As per claim 19, Shkedy discloses:

a merchant interface enabling a merchant to access analyzed survey information, (Col. 11, line 22, [seller interface {300}]).

As per claim 20, Shkedy discloses:

wherein the stored consumer information is provided by a party to a transaction other than the merchant, (Col. 1, lines 8-12, [intermediary]).

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US 6,260,024), and further in view of Pinsley et al (US 6,070,145), and further in view of Kurland et al (US 4,603,232).

As per claim 11, Shkedy discloses:

wherein the information relating to the consumer in the transaction includes a consumer identification code, (Col. 5, lines 13-15, [buyer identification])

Both Shkedy and Pinsley et al fail to disclose, however Kurland et al discloses:

and the historical consumer information includes at least one of the number of invitations sent to the consumer and the number of surveys completed by the consumer, (Col. 7, lines 24-37, [mail-out-count/quota]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to keep track of the number of invitations sent to the

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consumer and the number of surveys completed by the consumer with the motivation of determining the customers that need more attention.

Response to Arguments

5. Applicant's arguments, see page 7, filed 4/19/04, with respect to claims 1-15 have been fully considered and are persuasive. The 35 USC 101 rejection of claims 1-15 has been withdrawn.

Applicant's arguments filed 4/19/04 have been fully considered but they are not persuasive.

As per claim 1, the applicant argues that the combination of Shkedy and Pinsley fails to disclose or suggest determining whether to invite a consumer to complete a survey related to a transaction since the survey is not "based on a t least partially on at least one of the consumer information and the merchant information" However, in Pinsley et al, the consumer is offered the opportunity to complete a survey based on selection criteria. In Pinsley et al, the selection criteria is show to be based on consumer information as shown in Col. 2, lines 30-37 where every Nth visitor is selected, where N is defined by offering criteria for a particular consumer. In this case, the offering criteria for a particular consumer represents consumer information.

As per claim 10, the applicant argues that the combination of Shkedy and Pinsley fails to disclose or suggest "instructions to cause a processor to...determine [or determining], using the historical consumer information, whether to collect survey information from the consumer in the transaction".

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However, Shkedy discloses developing historical consumer information for each of the participating consumers, in Col. 10, lines 1-7, where credit history for consumers is maintained in the buyer database. This information can be tracked according to a consumer tracking number. In addition, Pinsley discloses determining whether to collect survey information from the consumer in the transaction in Col. 4, lines 9-11, where an offer to participate in a survey is made at the conclusion of a transaction based on pre-determined criteria such as consumer offering criteria. This consumer offering criteria is embedded in instructions into an information document, as shown in col. 2, lines 3-10. Since this information is embedded in the document, this information is trackable, like the credit history consumer information of Pinsley. Therefore, the combination of Shkedy and Pinsley discloses "instructions to cause a processor to...determine [or determining], using the historical consumer information, whether to collect survey information from the consumer in the transaction". The Pinsley reference was used to cure the deficiencies of Shkedy, and show that one can determine whether or not to collect survey information represented by trackable information. Since the consumer credit history information of Shkedy is also trackable, the combination is valid and teaches the limitation.

As per claim 16, the applicant argues that the combination of Shkedy and Pinsley fail to disclose or suggest a processor configured "to determine whether to solicit survey information from the consumer to the transaction based at least partially on the transaction record". However, as described above with respect to claim 1, Pinsley et al, discloses that the consumer is offered the opportunity to

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complete a survey based on selection criteria. In Pinsley et al, the selection criteria is shown to be based on consumer information as shown in Col. 2, lines 30-37 where every Nth visitor is selected, where N is defined by offering criteria for a particular consumer. In this case, the offering criteria for a particular consumer represents consumer information. In addition, Pinsley discloses that the bias for selecting consumers is affected by the frequency of consumers visiting the site. In this case, the consumers visiting the advertiser's site represents the transaction.

The applicant also argues that there is no motivation to combine the Shkedy and Pinsley references. However, these references are combinable since they both disclose network-based systems for facilitating transactions between buyers or consumers and sellers or advertisers.

As per claim 11, the applicant argues that Kurland does not overcome the deficiencies of the combination of Shkedy and Pinsley and that there is no motivation to combine the references. However, as disclosed above in the rejection, Kurland discloses that the historical consumer information includes at least one of the number of invitations sent to the consumer and the number of surveys completed by the consumer, in Col. 7, lines 24-37. Here, the mail-out-count/quota represents the number of surveys completed by the consumer since Kurland discloses that the "mail-out-count" can be used by a market survey organization to assess response rates which are normally employed in a survey study. In addition, Kurland is combinable with Shkedy and Pinsley since Kurland deals with the accumulation of survey data, which is an information document.

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For the reasons discussed above, the rejections have been maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-


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746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.
July 12, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600